

REMARKS

Reconsideration of the above-identified application respectfully is solicited on behalf of the Applicants. The following rejections are noted:

- Claims 1, 4, 9, 11-15, 20, 23, 28, and 30-34 under 35 U.S.C. § 102(e) as being anticipated by Miska, U.S. Patent No. 6,541,6989; and
- Claims 2, 3, 5-8, 10, 16-19, 21, 22, 24-27, 29, and 35-39 under 35 U.S.C. § 103(a) as being unpatentable over Miska.

As to independent claim 1, directed to a shield, and independent claim 20, directed to an assembly including such shield, both of these claims as filed recite that the second member is “integrally joined” to the first member. For example, and as is described at page 11, lines 6-24 of the specification, the second member may be molded or bonded to the first section.

Turning then to the Miska, the gasket (10), as to which the Examiner considers the film (15) of the sheath (14) thereof to be equivalent to the claimed second member, does not appear to be integrally joined to the surfaces (16, 18). Rather, “the gasket is disposed for use between [the] adjacent metal surfaces **16, 18 . . .**” [Miska, at col. 5, ll. 66-67]. Indeed, Miska mentions that, “over time, there is relative movement between the metal surfaces **16, 18** and the gasket **10 . . .**” [*Id.*, at col. 5, ll. 41-42].

As Miska does not appear to disclose the claimed feature that the second member is “integrally joined” to the first member, claims 1 and 20 are submitted to be novel over the art made of record. See *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990), *citing Diversitech Corp. v. Century Steps, Inc.*, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988) (for a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in the single reference); See also *In re Spada*, 15 U.S.P.Q.2d 1655, 1657 (Fed Cir. 1990) (rejection for anticipation requires that all the elements of the claimed invention be described in a single reference, and that the reference describe the claimed invention sufficiently to have placed one of ordinary skill in the art in possession of it); and *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) (finding the Board to have erred in ignoring a claimed limitation of which the prior art did not disclose).

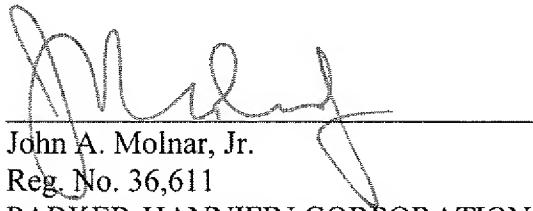
Regarding the dependent claims, claims 9 and 28 specify that the second member is “self-bonded” to the first member, such as via the insert molding process mentioned at page 11, lines 11-24 of the specification. It is believed that this feature is neither shown nor suggested in the art currently made of record.

The remaining dependent claims 2-8, 10-19, 21-27, and 29-39 further describe, respectively, independent claims 1 or 20, and therefore should be considered allowable for the reasons given in connection therewith.

Appl. No. Serial No. 10/764,956  
Response dated May 04, 2006  
Reply to Office action of November 04, 2005

In view of the foregoing remarks, the issuance of a Notice of Allowance is solicited.

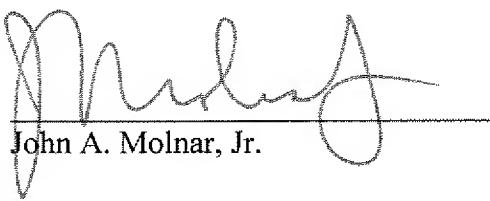
Respectfully submitted,



John A. Molnar, Jr.  
Reg. No. 36,611  
PARKER-HANNIFIN CORPORATION  
6035 Parkland Boulevard  
Cleveland, OH 44124-4141  
Voice: (216) 896-2212  
Fax: (216) 896-4027  
E-mail: jmolnar@parker.com

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I hereby certify that this correspondence is being electronically filed with the United States Patent and Trademark Office on this 04<sup>th</sup> day of May, 2006.



John A. Molnar, Jr.